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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,912	07/13/2001	Barbara A. Christensen	RA 5379 (33012/315/101)	4606
27516	7590	02/16/2005	EXAMINER	
UNISYS CORPORATION			CARDONE, JASON D	
MS 4773			ART UNIT	
PO BOX 64942			PAPER NUMBER	
ST. PAUL, MN 55164-0942			2145	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/904,912	Applicant(s) CHRISTENSEN ET AL.	
	Examiner Jason D Cardone	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner, on form PTO-892, has cited the references, they have not been considered [Example in Specification: Mapper User Manuel page 20, and Cool Ice User Manuel, page 26].

2. The disclosure is objected to because of the following informality: a co-pending application is referenced on page 23 needs to be updated. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Regarding claim 1, the word "means" is preceded by the word(s) "responsively coupled" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

5. Claim 1 recites the limitations "said responding means" and "said providing means" in lines 7-8. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 2 recites the limitation "said notifying means" in line 1. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 16 recites the limitation "the improvement" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 6-10 of USPN 6,324,539, claims 11-15 of USPN 6,662,343 and claims 1-1-20 of USPN 6,295,531 contain every element of claims 1-10 of the instant application and as such anticipate claims 1-10 of the instant application. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or

anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, 6-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersen, USPN 6,363,398, in view of Guinart, USPN 6,687,897.

12. Regarding claim 6, Andersen discloses an apparatus comprising: a user terminal, which initiates a service request [Andersen, col. 3, lines 51-67];

a gateway responsively coupled to the user terminal via a publicly accessible digital data network [Andersen, col. 3, line 60 – col. 4, line 16]; a translation module, which converts, the service request into a series of command language script elements [ie. ASP, Andersen, col. 5, lines 40-64];

a database management system responsively coupled to the translation module and to the user terminal via a the gateway which a notification module responsively coupled to the translation module which identifies a first particular command language script element as within a first format which is compatible with the data base management system [Andersen, col. 5, line 40 – col. 6, line 66]

Andersen does not disclose a second particular command language script element as within SGML-derived syntax. However, Guinart, in the same database endeavor, discloses multiple different command language scripts sent to a database management system, which a second particular command language script element as within SGML-derived syntax [Guinart, col. 2, lines 26-67, col. 3, lines 39-63, and col. 8, lines 10-48]. It would have be obvious to one of ordinary skill in the art, at the time of the invention, to incorporate a second particular command language script element, taught by Guinart, in to the database management system, taught by Andersen, in order to easier manage each different command language script as one file.

13. Regarding claim 7, Andersen-Guinart further discloses the publicly accessible digital data communication network further comprises the Internet [Andersen, col. 4, lines 31-59] [Guinart, col. 1, lines 49-61].

14. Regarding claim 8, Andersen-Guinart further discloses a coded command language script element which identifies the next succeeding command language script

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element as within SGML-derived syntax [Andersen, col. 4, line 60 – col. 5, line 39]
[Guinart, col. 3, lines 58-63 and col. 6, lines 31-42].

15. Regarding claim 9, Andersen-Guinart further discloses the user terminal further comprises an industry compatible personal computer containing a web browser [Andersen, col. 4, lines 31-59] [Guinart, col. 1, lines 49-61].

16. Regarding claims 11-14, 16, 17 and 19, claims 11-14, 16, 17 and 19 have similar limitations as disclosed in claims 6-9. Therefore, the similar limitations are disclosed under Andersen-Guinart for the same reasons set forth in the rejection of claims 6-9 [Supra 6-9].

17. Regarding claims 15 and 18, claims 15 and 18 have similar limitations as disclosed in claims 6-9 with the additional limitations of the uniquely coded command language script element further comprises "@BRK". Therefore, the similar limitations are disclosed under Andersen-Guinart for the same reasons set forth in the rejection of claims 6-9 [Supra 6-9]. Andersen-Guinart further discloses an element in the command language script is a break between scripts [Andersen, col. 4, line 60 – col. 5, line 39] [Guinart, col. 6, lines 53-64].

18. Claims 4, 5, 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersen-Guinart as applied to claims 3, 9 and 19 above, and further in view of Applicant's Admission ("Admission").

19. Regarding claims 4, 10 and 20, Andersen-Guinart substantially discloses the claimed invention. Andersen-Guinart does not specifically disclose the MAPPER (CLASSIC MAPPER) database management system. However, Admission discloses that the MAPPER (CLASSIC MAPPER) database management system is well known in the art [Specification, page 1, lines 15-20]. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate the MAPPER database, taught by Admission, into the database management system, taught by Andersen-Guinart, in order to use different databases.

20. Regarding claim 5, Andersen-Guinart-Admission further discloses an industry standard personal computer [Andersen, col. 4, lines 31-59] [Guinart, col. 1, lines 49-61].

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin Wallace can be reached on (571) 272-6159. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
Primary Examiner
Art Unit 2145

February 4, 2005